

REMARKS

Claim 45 is amended.

Claims 1-40, 44 and 45 are pending and are the only claims in this application.

Claims 1 and 44 are independent claims.

Claims 12-34 stand withdrawn as being drawn to a non-elected invention.

Claims 1-11, 35-40, 44 and 45 under consideration.

All claims under consideration are finally rejected.

Rejections under 35 USC 112

Claim 45 is rejected under 35 USC 112, second paragraph, for reasons of record.

The term "CIBAFast® W" is deleted as requested.

Applicants submit that in light of this amendment, that the 35 USC 112, second paragraph rejections are addressed and are overcome.

Rejections under 35 USC 103(a)

Claims 1-11, 35-40, 44 and 45 are rejected under 35 USC § 103(a) as obvious over Seltzer, et al., U.S. Pat. No. 5,051,511 (Seltzer '511) in view of Rogers, et al., U.S. Pat. No. 5,459,222 (Rogers '222).

The claims under consideration are again rejected as obvious over the cited references for reasons of record.

Applicants again respectfully disagree and traverse the rejections. Applicants reiterate their arguments presented in the Response filed Sep. 21, 2001.

The Examiner bases the present rejections on the disclosure in Seltzer '511 that optional stabilizers including N,N-diethylhydroxylamine may be added to for example polyurethane or polyester coating compositions, combined with the Rogers '222 teaching that polyurethane or polyester coating compositions including benzotriazole UVA's can be used to coat paper and textiles to prevent fading of dyes.

As previously discussed, Rogers '222, although generically mentioning the treatment of paper, only exemplifies the prevention of dye fading in brown aniline leather. Applicants argued that polyurethane and polyester coatings are unknown as paper coatings and that therefore there is no motivation provided to combine the two references in order to solve the present problem of preventing loss of brightness and resistance to yellowing in pulp or paper. Known paper coatings use natural binders such as starch, soy protein or casein, or synthetic latices made from styrene/butadiene, vinyl acetate, vinyl-acrylic, acrylic or vinyl alcohol polymers.

To support this assertion, Applicants submit a Declaration under Rule 132 by Mr. David Vidal, an expert in paper coating employed at the Pulp and Paper Research Institute of Canada. Mr. Vidal states that polyurethane and polyester coatings are unknown as paper coatings. He also cites three references; "The Coating Processes", 1993, pages 15-18; "Pigment Coating and Surface Sizing of Paper", 2000, page 799; and "Handbook for Pulp and Paper Technologists", Second Ed., 1997, page 288 as evidence to support his statement. These references are also attached.

Applicants aver that in light of the Vidal Declaration, the present remarks, and the arguments of record in the Response filed Sep. 21, 2001, that the present rejections of claims 1-11, 35-40 and 44 under 35 USC 103(a) are addressed and are overcome.

Applicants respectfully request the Examiner to reconsider and to withdraw the rejections.

Applicants submit that claims 1-11, 35-40, 44 and 45 are in condition for allowance and respectfully request the Examiner to find them allowable.

Applicants further note that relevant copending applications have not been brought to the Examiner's attention. This Applicants now do. Please find attached for consideration copies of application Nos. 09/481,665, filed Jan. 12, 2000 and 09/483,017, filed Jan. 13, 2000. The references are cited on PTO form 1449. The Examiner is kindly requested to indicate that each reference is considered by returning an initialed copy of PTO form 1449.

Respectfully submitted,



Tyler A. Stevenson
Agent for Applicants
Reg. No. 46,388

Ciba Specialty Chemicals Corp.
540 White Plains Road
P.O. Box 2005
Tarrytown, NY 10591-9005
Tel. (914)785-2783
Fax (914)785-7102

Attachments: Appendix with marked-up claim 45

Declaration under Rule 132

PTO form 1449

"The Coating Processes", 1993, pages 15-18

"Pigment Coating and Surface Sizing of Paper", 2000, page 799

"Handbook for Pulp and Paper Technologists", Second Ed., 1997, page 288

Copy of application No. 09/481,665, filed Jan. 12, 2000

Copy of application No. 09/483,017, filed Jan. 13, 2000

APPENDIX: Marked-up Claim 45

45. (amended) A composition according to claim **44** which additionally includes an effective stabilizing amount of 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid, sodium salt-
(CIBAFast®-W).